

To establish a *prima facie* case of obviousness, the Patent Office must satisfy three requirements. First, the prior art reference or combination of references must teach or suggest all of the limitations of the claims. See *In re Wilson* 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art"). Second, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *In re Fine*, 837 F.2d at 1074; *In re Skinner*, 2 U.S.P.Q.2d 1788, 1790 (Bd. Pat. App. & Int. 1986). Third, the proposed modification or combination of the prior art must have a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. See *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209, 18 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1991).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. See M.P.E.P. § 2143. Moreover, to support combining references in a Section 103 rejection, evidence of a suggestion, teaching, or motivation to combine must be clear and particular, and this requirement is not met by merely offering broad, conclusory statements about teachings of references. See *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Finally, as discussed in M.P.E.P. 706.02(j) it is important that the basis for a rejection be communicated properly so that an applicant is given a fair opportunity to respond to the rejection. Furthermore, it is also important that the written record be clear as to the rationale behind decisions made during the prosecution of a patent. M.P.E.P. 706.02(j). Such is the case because the rationale behind decisions in a case may affect the claim scope of an issued patent and, absent a clear explanation of how references are applied in a particular case, the applicant will not be provided a fair opportunity to address or rebut the rationale of the examiner.

The Independent Claims Are Patentable Over the Alleged APA and Gish

Claims 1, 9, 17 and 25 are independent claims. Of these claims, Claims 1, 9 and 17 have similar recitations. Accordingly, the rejection of Claims 1, 9 and 17 will be discussed with reference to Claim 1, which recites:

1. (Amended) A method of automatically translating text with **a reusable control**, comprising the steps of:
initializing parameters to identify a plurality of variables comprising at least a source and a target language;
identifying when **translation should be invoked for text** in the control; and
encapsulating said steps of **initializing and identifying** in order to make **a reusable data object**.

(emphasis added). Applicant submits that the alleged APA and Gish do not, alone or in combination, disclose or suggest the highlighted portions of Claim 1.

Turning to the alleged APA, Applicant submits that the alleged APA does not disclose a "reusable control" as asserted in the Official Action. *See* Official Action, p. 2. As is clear from the present specification, the prior art illustrated in Figure 3 of the present application did not provide a reusable control. As described on pages 5 and 6 of the present specification, the programmer utilizing the prior art techniques carries out the programming steps of block 350 for each application that is written. Such is clearly the case as the specifics of the programming of the application depends on the machine translation API selected by the programmer. Specification, pp. 5-6. Thus, the present specification states that "[u]se of these API's must then be combined with each separate input, output or other control to provide a useful solution." Specification, p. 6. Accordingly, a reusable control is not provided by the alleged APA but custom controls which must be written for each separate input, output or other control are described. Applicant, therefore, submits that the alleged APA is interpreted as teaching more than is actually taught by the present specification with regard to the prior art. Therefore, the rejection based on the alleged APA should be withdrawn as the alleged APA does not disclose or suggest a reusable control as recited in Claims 1, 9 and 17.

Furthermore, Gish fails to provide the teachings missing from the alleged APA. In particular, neither the alleged APA nor Gish disclose the encapsulation recited in Claims 1, 9 and 17. The encapsulation recited in Claims 1, 9 and 17 is of the **identification of when** to

perform a translation and the initialization of parameters, including a source and a target language.

In contrast to the recitations of Claims 1, 9 and 17, Gish merely describes encapsulation in general or in a context different from that of the present invention. Gish does not describe encapsulation of the initialization of a source and a target language or when such a translation should occur. Claims 2 and 9 of Gish describe translating user interface information into display information, not translation of text from a source language to a target language. Similarly, Figure 23 and column 25, lines 15-38 of Gish describe message processing where user interface event signatures are encapsulated and transformed into a model map. While the cited portion of Gish does use the word encapsulate, it is used in a completely different context from the present invention. Applicant is not attempting to claim the concept of encapsulation but is, in fact, claiming a specific use of encapsulation as it relates to machine translation of language. Such a use of encapsulation is neither disclosed nor suggested by Gish or the alleged APA, either alone or in combination.

Furthermore, there is no reason to combine the alleged APA, which relates to the programming of language translation on a control by control basis for an application, with the *Object-Oriented System, Method and Article of Manufacture for a Presentation Engine in an Interprise Computing Framework System* of Gish. Gish describes a presentation engine and does not relate to language translation, whereas the alleged APA does not relate to object oriented programming or to a presentation engine. As such, Applicant submits that the only basis for combining the alleged APA and Gish is through the impermissible use of hindsight.

Applicant further submits that the reasoning provided in the Official Action for why one of skill in the art would combine Gish and the alleged APA to result in the recitations of the claims is also the kind of conclusory assertion that is generally rejected by the Federal Circuit. Merely stating that the combination would render the system less complex is insufficient to meet the requirements of establishing a prima facie case of obviousness. If such were the case, all things that made a system less complex would be obvious.

It is also not clear that the combination of the alleged APA and Gish would in fact make the resulting system less complex. In general, object oriented programming is not considered less complex than non-object oriented programming but may be simpler to program and may provide portability of programming objects. Furthermore, the combination

of the presentation engine of Gish and the control by control programming of language translation of the alleged APA would not necessarily be less complex than either system alone.

In light of the above discussion, Applicant submits that Claims 1, 9 and 17, and the claims which depend from them, are patentable over the alleged APA and Gish as each of the recitations of the independent claims are not found in the cited references and the references are not properly combinable to result in the recitations of the claims.

With regard to independent Claim 25 and the claims which depend from Claim 25, these claims are also patentable over the alleged APA and Gish. Claim 25 recites:

25. (New) A **control object for controlling text**, the control object comprising:
a **text property** for storing data corresponding to the text to be controlled by the control object;
a **translation language property** which indicates a language to which the text to be controlled is to be translated; and
a **translation method** which performs translation of data in the text property.

(emphasis added). Claim 25 is patentable over Gish and the alleged APA for reasons similar to those discussed above. Applicant further submits that such a control object is expressly identified as **not** conventional in the present specification. See Specification, p. 9. Thus, the alleged APA does not disclose **any** of the recitations of Claim 25 as the alleged APA does not disclose a control object for controlling text which has any one of: a text property; a translation language property; and a translation method. Furthermore, Gish does not relate to language translation and, therefore, also does not disclose any of the recitations of Claim 25. As such, Applicant submits that Claims 25 to 28 are patentable over the alleged APA and Gish for at least these additional reasons and, therefore, requests allowance of these claims. To the extent that such rejection is maintained, Applicant requests that the Examiner explain how any of the recitations are found in either the alleged APA or Gish.

Finally, with regard to the dependent claims and Claim 25, Applicant submits that a prima facie case of obviousness has not been established because the Official Action has failed to point out where in the cited references each of the recitations of the claims has been found. None of the recitations of any of the dependent claims or of Claim 25 are mentioned in the Official Action. Applicant submits that Applicant has not had a fair opportunity to

address the rationale of the rejection and, therefore, submits that the rejection should be withdrawn. As such, Applicant submits that Claim 25 and each of the dependent claims is separately patentable over the cited references as the Official Action has failed to identify where in the references any of the recitations of these claims is found or explain why and how the references could be combined to result in the recitations of the dependent claims.

CONCLUSION

Having addressed each of the issues raised in the Official Action, Applicants submit that the present application is in condition for allowance, which action is respectfully requested.

Respectfully submitted,



Timothy J. O'Sullivan
Registration No. 35,632

Correspondence Address

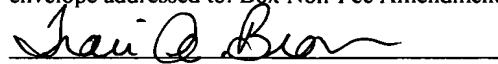


20792

PATENT TRADEMARK OFFICE

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box Non-Fee Amendment, Commissioner for Patents, Washington, DC 20231, on October 31, 2001.



Traci A. Brown

Date of Signature: October 31, 2001